

In the Final Office Action the Examiner indicated that the claims are rejected under 35 U.S.C. 112 as failing to comply with the description requirement.

In the Examiner's opinion the acting medicinal substance and the potentiated medicinal substance are the same, and there are no distinctions between the two components.

Applicant has to respectfully disagree with this position for the following reasons.

It has been explained in the previous communications that the acting medicinal substance is a substance produced in a conventional way as all medications. The potentiating medicinal substance is not the same as the acting medicinal substance. While it can be produced from the same initial material, it is produced in a totally different way in a homeopathic process, so that the potentiated medicinal substance is a totally different substance.

It is therefore believed that the Examiner's grounds for the rejection of the claims under 35 U.S.C. 112 should be considered as no longer tenable and should be withdrawn.

The Examiner rejected the claims over the patent to Amitai under 35 U.S.C. 102 as being anticipated.

As for this rejection, the patent to Amitai does not disclose a method for making medication in accordance with which an active medicinal substance is produced, then a potentiated medicinal substance is produced via homeopathic method, and both substances are united to make a final medication before introduction into an organism, or are introduced into an organism separately.

It is therefore believed that the Examiner's grounds for the rejection of the claims under 35 U.S.C. 102 as being anticipated should be considered as no longer tenable and should be withdrawn.

The Examiner further rejected the claims over the patent to Amitai under 35 U.S.C. 103 as being obvious.

It was explained herein above, that the patent to Amitai did not teach the new features of the present invention as defined in the claims.

Also, the patent to Amitai does not disclose any hint or suggestion that such features can be provided in it. Therefore, there is no ground for any obviousness rejection.

It is believed that the Examiner's rejection of the claims under 35 U.S.C. 103 should be also be considered as not tenable and should also be withdrawn.

As for the anticipation rejection, it is believed to be advisable to cite the decision in re Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co., 221 USPQ 481, 485 (Fed. Cir. 1984) in which it was stated:

"Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim."

Definitely, the reference does not contain each and every feature of the present invention as defined in the claims, and therefore the anticipation rejection should be considered as not tenable and should be withdrawn.

As for the obviousness rejection, the reference does not contain any hint or suggestion for the applicants invention.

In order to arrive at the applicant's invention from the teaching of the reference, the reference has to be fundamentally modified, in particular by including into it the new features of the present invention which are now defined in the claims. However, it is known that in order to arrive at a claimed invention, by modifying the references the cited art must itself contain a suggestion for such a modification.

This principle has also been consistently upheld by the U.S. Court of Customs and Patent Appeals which, for example, held in its decision in re Randol and Redford (165 USPQ 586) that

Prior patents are references only for what they clearly disclose or suggest; it is not a proper use of a patent as a reference to modify its structure to one which prior art references do not suggest.


In view of the above presented remarks and amendments, it is believed that the claims currently on file should be considered as patentably distinguishing over the art and should be allowed.

Reconsideration and allowance of the present application is most respectfully submitted.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in


formal respects in order to place this case in condition for final allowance, then it is respectfully requested that such amendments or corrections be carried out by Examiner's Amendment, and the case be passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, he is invited to telephone the undersigned (at 631-243 38 18).

Respectfully submitted,

  
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Extension Request

Please extend the term by 1 month  
and charge to acc. 26-0085.

  
R.N. 28 563